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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/628,631      | 07/28/2003  | Fred Monroe          | 03-748              | 4899             |

39310 7590 10/18/2006  
MBHB/TRADING TECHNOLOGIES  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

AKINTOLA, OLABODE

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3691

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/628,631             | MONROE ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Olabode Akintola       | 3691                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1- 22 is/are pending in the application.
- 4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 11 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Garber (U.S. Patent No. 5963923).

Re claims 1 and 22: Garber teaches a method for sending an order to an electronic market, comprising: sending an order on behalf of a trader from a first electronic market to a second electronic market (col. 4, lines 5-8: “*facilitate intermarket trading*” see explanation in response to arguments below), wherein the first electronic market comprises a first computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a first tradable object and the second electronic market comprises a second computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a second tradable object and wherein the second tradable object is different from the first tradable objects (col. 4, lines 38-42), the order being sent using a microprocessor executing one or more instructions (col. 4, lines 5-8 & lines 32-44).

Re claim 2: Garber teaches the step of sending is performed when a condition is satisfied (col. 6, lines 45-55)

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Re claim 3: Garber teaches the step of receiving a first order at the first electronic market (col. 4, lines 32-36).

Re claim 4: Garber teaches the step wherein the condition comprises at least a portion of the first order being filled (col. 6, lines 45-55).

Re claim 5: Garber teaches the step of receiving a market event request message at the first electronic market that establishes a condition (col. 8, lines 14-27).

Re claim 6: Garber teaches the step wherein the condition is in the form of a lookup table (col. 8, lines 20-22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Bykowsky et al. (U.S. Patent Application No. 20020013757) (hereinafter referred to as Bykowsky).

Re claim 7 and 8: Garber is as discussed above. Garber does not explicitly teach the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader. Bykowsky teaches the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader (section [0055]: *buyers and sellers have one or more opportunities to modify a previously submitted buy or sell order*). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader as taught by Bykowsky. One would have been motivated to do this in order to provide an opportunity to adjust a previously submitted order.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Hauk et al. (U.S. Patent Application No. 20030126068) (hereinafter referred to as Hauk).

Re claim 9: Garber is as discussed above. Garber does not explicitly teach the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm. Hauk teaches the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market

according to a first-in-first-out (FIFO) matching algorithm (section [0066]: *An algorithm for trade matching, based on prorated or FIFO trading match scheme could be incorporated*). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm as taught by Hauk. One would have been motivated to do this because FIFO matching scheme is old and well known in the art.

### ***Response to Arguments***

Applicant's arguments filed 9/19/2006 have been fully considered but they are not persuasive.

With regards to claim 1, 10, 11 and 22, applicant argues that Garber system does not show an “electronic market” and “sending an order on behalf of a trader”. Examiner respectfully disagrees. Garber teaches a link between futures and options computers to facilitate intermarket trading. Examiner interprets intermarket trading as defined in The Free Dictionary by Farlex (see notice of references cited) as electronic communications network linking the trading floors of seven registered exchanges to permit trading among them in stocks listed on either the NYSE or AMEX and one or more regional exchanges. Through ITS, any broker or market maker on the floor of any participating exchange can reach other participants for an execution whenever the nationwide quote shows a better price available. A floor broker on the exchange can enter an ITS order to assure execution of all of an offering or bid, instead of splitting it with competing brokers (see attached). Therefore, the futures and options computers

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as taught in Garber to facilitate the intermarket trading are interpreted as electronic exchanges/markets. Also, since brokers are involved in these electronic markets, it is considered that these brokers send orders on behalf of traders to be executed on any participating exchange when a condition (nationwide quote shows better price available) is satisfied.

Re claims 7 and 8: The applicant argues that in Bykowsky, buyers and sellers do the modifying directly. Examiner respectfully disagrees. Bykowsky teaches that orders are sent either by the sellers/buyers or *their agents*. It would have been obvious to one of ordinary skill in the art that any modifications to said orders could either be done directly by the sellers/buyers or on their behalf through their agents/brokers.

In view of the explanation given above, the argument regarding claim 9 is moot.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571- 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI  
PRIMARY EXAMINER